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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/917,143

07/27/2001

Francis M. Sherwin

PRA 2 0006

1378

7590

10/04/2006

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EXAMINER

BEKERMANN, MICHAEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/917,143

Applicant(s)

SHERWIN ET AL.

Examiner

Michael Bekerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-28 is/are pending in the application.
- 4a) Of the above claim(s) 24-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

This action is responsive to papers filed on 7/17/2006.

### ***Election/Restrictions***

1. Newly submitted claims 24-28 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The above claims and the original claims are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, the new claims have separate utility such as a user of the system may set up the shopping portal without the shopping portal ever being implemented. See MPEP § 806.05(d).

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 24-28 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**2. Claim 17 is rejected under 35 U.S.C. 102(e) as anticipated by Bain (U.S. Patent Pub. No. 2001/0053997).**

Regarding claim 17, Bain teaches Applicants' claimed invention, including (a) receiving a shopper/shoppers at a first web-site maintained on the communications network, the shopper having an affinity group associated therewith (FIG. 1, "Preference Processing Site (PPS) 10"); (b) forwarding the shopper/shoppers to a (selected one of a plurality of) second web-site/sites maintained on the communications network (Para. 0027, "hyperlinking from the PPS to the Vendor"); (c) obtaining a generated click-through fee related to the forwarding of the shopper/shoppers to the second web-site/sites (Paras. 0024, 0028); (d) distributing a portion of the obtained click-through fee to the respective affinity group associated with the shopper/shoppers (Para. 0030, NPO receives commission from PPS); and, (e) communicating to the shopper/each shopper how much was distributed to their associated affinity group (Paras. 0036-0037, since the specials and incentives such as double points/commissions (Applicants' "how much") are provided to influence the behavior of purchasers, such influence requires

that these specials are communicated to purchasers; and Para. 0006, tax deductible gifts necessitate that the actual portion of the purchase donated to an NPO is measurable so a purchaser can file for the appropriate amount of tax deduction).

Further, Bain teaches means for a representative of an affinity group to create a customized shopping portal for the affinity group (Para. 0030, NPO registers its site and provides additional information to present to a purchaser).

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claim 12 is rejected under 35 U.S.C. 103(a) as unpatentable over Bain (U.S. Patent Pub. No. 2001/0053997).**

**Regarding claim 12, Bain explicitly teaches that the purchaser's selection results in a tax deductible gift (Bain at Para. 0006). On the other hand, Bain does not explicitly disclose that the shopper's identity is communicated to the affinity group/NPO. However, Official Notice is taken that NPOs often send to donors thank you letters or receipts for donors' tax records recording at least the amount of donations. Such correspondence requires that the NPO have received the identity of the donor/purchaser. Accordingly, it would have been obvious to one skilled in the art at the time of Applicants' invention to modify Bain to include communicating the identity of the**

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shopper/donor for the purpose of sending the shoppers' confirmation of the amount of the donation for the shoppers'/donors' tax records.

**4. Claims 13-16 are rejected under 35 U.S.C. 103(a) as unpatentable over Bain in view of Dorff et al. (U.S. Patent Pub. No. 2001/0025263, herein "Dorff").**

Regarding claims 13-16, Bain does not explicitly teach that if the identifying means does not identify a received shopper that is responsible for a distribution being made by the distributing means, then the communicating means indicates that the distribution is made anonymously. However, Dorff expressly provides these limitations (Dorff at Para. 0026). Accordingly, it would have been obvious to one skilled in the art at the time of Applicants' invention to modify Bain to the feature of anonymous giving as taught by Dorff for advantageously enabling a purchaser to experience the satisfaction of charitable giving (Dorff at Para. 0006).

Bain explicitly teaches the features recited in Applicants' Claims 14-16, including that the forwarding means permits shoppers to choose which shopping site they are forwarded to from a plurality of different shopping sites (Para. 0034), that the portion distributed by the distributing means is based upon an amount of purchases observed by the monitoring means (Para. 0028), and that the communications network is the Internet (FIG. 1 at 20).

5. **Claims 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bain in view of Slatalla. (Slatalla, Michelle, "User's guide; Building Web Pages Is Child's Play", The New York Times, May 7, 1998, Pg G11.).**

**Regarding claims 18-23, Bain** teaches an online community in which NPOs may link a webpage or submit information for display on the PPS (Para. 0030). Bain does not specify a web-based interface for building web pages according to the above claims. Slatalla teaches an online community called Geocities, in which web-based HTML editors were used to choose text color and graphical elements. It would have been obvious to one having ordinary skill in the art at the time the invention was made for Bain to allow altering of the appearance of the NPO information at the time of submittal. This would give each NPO page a unique feel.

### ***Response to Arguments***

In response to the 102(e) rejection of claim 17, applicant argues "the Office Action provides no support for the alleged rejection". Examiner would like to refer applicant to the underlined portion of the 102(e) rejection in the current action. This portion was originally included verbatim in the Non-Final action sent on 1/13/2006. While the heading "regarding claim 17" was left out of the action, the underlined portion discloses the subject matter of claim 17 and provides reasoning behind the rejection.

### ***Conclusion***

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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**JEFFREY D. CARLSON**  
**PRIMARY EXAMINER**